



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Michael William URBANSKI et al.

Title: METHOD, SYSTEM, AND SOFTWARE FOR GEOGRAPHICALLY
FOCUSED NETWORK ADVERTISING

Appl. No.: 09/714,665

Filing Date: 11/17/2000

Examiner: D. Champagne

Art Unit: 3622

TRANSMITTAL FOR APPEAL BRIEF

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Appeal Brief in the above-identified application.

☒ [X] Small Entity status under 37 C.F.R. § 1.9 and § 1.27 has been established by a
previous assertion of Small Entity status.

☐ [] Applicant hereby petitions for an extension of time under 37 C.F.R. §1.136(a) for the
total number of months checked below:

<input type="checkbox"/>	Extension for response filed within the first month:	\$120.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the second month:	\$450.00	\$0.00
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	EXTENSION FEE TOTAL:		\$0.00
<input checked="" type="checkbox"/>	Appeal Brief Under 37 CFR § 41.37	\$500.00	\$500.00
	Extension and Appeal Brief fees		\$0.00
<input checked="" type="checkbox"/>	Small Entity Fees Apply (subtract ½ of above):		\$250.00
	TOTAL FEE:		\$250.00

☐ Please charge Deposit Account No. 19-0741 in the amount of \$0.00. A duplicate copy of this transmittal is enclosed.

☒ A check in the amount of \$250.00 for the Appeal Brief filing fee is enclosed.

☒ The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date May 16, 2005 (Monday)

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following is the Appellant Appeal Brief under the provisions of 37 C.F.R.
§ 41.37. The required fee set forth in § 41.20(b)(2) is also enclosed.

1. Real Party in Interest

The real party in interest are the inventors, Michael William Urbanski and Charles
David Dent, sole inventors.

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2. Related Appeals and Interferences

There are no related appeals or interferences that will directly affect, be directly
affected by or have a bearing on the present appeal, that are known to appellant, the assignee,
or the appellant's patent representative.

3. Status of Claims

The present appeal is directed to claims 1-39 which are the claims under
consideration. A copy of the pending claims 1-39 are attached herein in the Claims Appendix
(Section 8).

Claims 1-13, 15-28, 30, 31, 36, and 37 are finally rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 5,432,542 ("Thibadeau"). Claims 14 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thibadeau. Claims 32-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thibadeau, in view of U.S. patent no. 5,155,591 ("Wachob"). Claims 38 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thibadeau.

Claims 36-39 are objected to under 37 C.F.R. § 1.75(c), as being as being of improper dependent form for failing to further limit the subject matter of a previous claim.

4. Status of Amendments

Claims 1-33 were initially pending in the application filed on November 17, 2000. Claims 1, 16, and 31-33 were amended and claims 34-39 were newly added in an Amendment and Reply Under 37 C.F.R. § 1.111 filed June 10, 2004 in reply to a first Office Action on the merits mailed on February 10, 2004.

A final Office Action was mailed on September 14, 2004.

5. Summary of the Claimed Subject Matter

Independent claims 1, 16, and 31 are directed to a software based system and method of displaying location based information from an information site on a network by determining location data of a user of the location based information on the network.

Figure 2 of the application discloses one or more computer/communication devices (110A, 110B) communicating with a server device 120 through an electronic network 100.

As disclosed, for example, in page 5, lines 20-27 of the specification, an information site represents a computer server (for example, the computer server device 120) that is connected to a private or public network (such as the Internet). The network is defined in page 9, lines 23-29, and includes a public network, a virtual private network, or a private network such as a local area network (LAN) or a wide area network (WAN).

The information site provides location based information to a user after determining location data of user. As described in page 6, lines 1-12 and page 10, lines 15-29, the location data may be geographical data which may be determined either by user interaction or by an automated process which determines the location data based on a user's network

address or other similar parameters that are indicative of a geographic location of the user (or a computer/communication device used by the user).

As shown with respect to step 330 the flow chart of Figure 3, the server generates location based information using, for example, a location information database 122B. The location based information is keyed to location data of a user either directly based on the location data or based on another database that translates the location data received from a user (or a device used by the user). The generated location based information may include information exclusively from respective sponsors in respective categories of information. One example of this process is discussed on page 14, lines 3-10, where exclusive sponsors provide information for specific categories of information.

The generated location based information is then provided to the user over the network for display or other presentation to the user as described, for example, on page 11, lines 9-14.

Independent claim 32 is directed to a method of displaying information from an information site on a network based on determining contextual information of the user. As described, for example, on page 12, lines 6-25, the contextual information may include information that is correlated to a characteristic of the user, profession or vocation of the user, type of computer/communication device used by the user, or any other information that assists a server device to determine information that may be useful to a user. The contextual information may be used in conjunction with location data as discussed in page 12, lines 20-25.

6. Grounds of Rejection to be Reviewed on Appeal

I. Whether the examiner erred in rejecting claims 1-13, 15-28, 30, 31, 36, and 37 under 35 U.S.C. § 102(b) as being anticipated by Thibadeau, and claims 14, 29, 38, and 39 under 35 U.S.C. § 103(a) as being unpatentable over Thibadeau.

II. Whether the examiner erred in rejecting claims 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Thibadeau in view of Wachob.

7. Argument

I. Claims 1-13, 15-28, 30, 31, 36, and 37 are not anticipated under 35 U.S.C. § 102(b) by Thibadeau, and claims 14, 29, 38, and 39 are patentable under 35 U.S.C. § 103(a) over Thibadeau.

Independent claims 1, 16, and 31 recite a method (or software/system) that displays location based information after determining, at an information site (or server device in claim 31), location data from a user of the location based information. The location based information is generated at the information site (or server device in claim 31) based on the determined location data. Thereafter, the generated location based information is provided to the user over a network. The generated location based information includes information exclusively from respective sponsors in respective categories of information. These recited features in the independent claims 1, 16, and 31 are not disclosed or suggested by Thibadeau.

First, Thibadeau discloses that information broadcast by a transmitter are selectively filtered at the user terminals. See, for example, lines 1-3 of the Abstract, col. 1, lines 53-57, and col. 4, lines 43-47 of Thibadeau. This is clearly very different from the claimed determination of location data and generation of location based information *at the information site* and subsequently providing the generated location based information to the user over a network.

Second, Thibadeau actually teaches away from the claimed configuration since it teaches advantages of the user filtering the broadcast information. See, for example, col. 4, lines 43-47 of Thibadeau which teaches that “[t]he end users have control of the geographic definition and can arrange to see, store, or otherwise process only messages relevant to selected geographic areas....” Therefore, Thibadeau does not teach or suggest the claimed feature of generation of location based information at the information site and actually teaches away from it.

Third, independent claims 1, 16, and 31 recite that the generated location based information includes information exclusively from respective sponsors in respective categories of information. This recited feature is also not disclosed or suggested by any of the cited references and provides another reason for the patentability of independent claims 1, 16, 31.

Erroneous conclusions in the Final Office Action

First, the final office action mailed September 14, 2004, states that the claimed “information site” reads on a tunable receiver (such as a television, VCR, or cable top receiver) as disclosed by Thibadeau. See col. 3, lines 42-50. To reach this conclusion, the office action states that the specification does not provide a specific definition of the information site. However, the specification defines an information site as a “computer server on a public or private network, such as the Internet.” See page 5, lines 20-21 of the specification. Clearly, the tunable receiver of Thibadeau is not a computer server.

However, even if one were to exalt form over substance and argue that there is no specific definition of an information site in a definitions section, the standard for the broadest reasonable interpretation of claimed term requires that the claim be interpreted in light of the specification and consistent with those skilled in the art would reach. MPEP §2111. One of skill in the art of computing business systems would, based on the specification, recognize that an “information site” is a computer server that communicates with a computing/communication device of a user over a network. Under such a standard, a tunable receiver cannot be considered a computer server and the direct connection between the tunable receiver and a display device (for example, TV) is not considered as a network communication.

Second, each of the independent claims require that generated location based information be provided by the information site to *a user over a network*. Even under the office action’s allegation that the tunable receiver of Thibadeau is an information site, nowhere does the office action allege where the information filtered by the tuner is provided to a user *over a network*. Interpreting the claimed network in light of the specification and from the perspective of one skilled in the business computing systems art, the network refers to an electronic network such as the Internet, a VPN, a LAN, or a WAN. See page 9, lines 23-29 of the specification. Nowhere does Thibadeau disclose that the tunable receiver communicate such information to a user over an electronic network as recited in the claims. In fact, the final office action is silent on this feature since it cites to col. 5, lines 58 to col. 6, line 10 of Thibadeau with respect to this feature (in paragraph 6 of the final office action) which only describes the classes of services that are facilitated by the Thibadeau invention and does not describe how the information from the tunable receiver is provided *over a network* to a user as required by the claims.

Of course, the Patent Office (PTO) has the burden of proving each of the claimed features is shown by the prior art. An allegation that claimed subject matter is “obvious” (or even more so for the anticipation alleged here) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO’s review court has made it very clear that silence in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966).

Therefore, the independent claims 1, 16, and 31 are patentable over the applied prior art. The dependent claims are also patentable for at least the same reasons as the independent claims on which they ultimately depend.

In view of the above, applicants respectfully submit that the rejections of claims 1-7, 10-13, 15-22, 25-28, 30, 31, 36, and 14, 29, 38, and 39 in the final office action is erroneous and should be withdrawn.

II. Claims 32-35 are patentable under 35 U.S.C. § 103(a) over Thibadeau in view of Wachob

Independent claim 32 recites determining contextual information, other than a location, of a user or device, and generating information based on the determined contextual information and providing the generated information over a network to the user or device. Independent claim 32 is also patentable over the combination of Thibadeau and Wachob.

As discussed in Section I earlier, at least the following features in claim 32 are not disclosed by Thibadeau for the same reasons as discussed in Section I: (1) determining contextual information of a user (at an information site), and (2) providing the generated information over a network to the user.

This deficiency in Thibadeau is not cured by Wachob. Specifically, Wachob also relates to cable television systems and the like and does not disclose the claimed information site which is a computer server device connected to a user over an electronic network. See col. 1, lines 7-14.. Furthermore, nowhere does Wachob teach that its converter (which the office action essentially alleges corresponds to the information site) provides generated information to a user over a network as required by claim 32. Therefore, claim 32, and all claims dependent therefrom, are patentable over the combination of Thibadeau and Wachob.

Accordingly, applicants respectfully submit that the rejections of claims 32-35 in the final office action is erroneous and should be withdrawn.

III. Conclusion

In view of above, appellants respectfully solicit the Honorable Board of Patent Appeals and Interferences to reverse the rejection of the pending claims and pass this application on to allowance.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

Date May 16, 2005 (Monday)

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8. Claims Appendix

1. (Once Amended) A computer implemented method of displaying location based information from an information site on a network, the method comprising the steps of:

determining, at the information site, location data of a user of the location based information on the network;

generating, at the information site, location based information based on the determined location data of the user; and

providing the generated location based information to the user over the network, wherein the step of generating location based information comprises providing information exclusively from respective sponsors in respective categories of information.

2. (Unamended) The method according to claim 1, wherein the location based information comprises location based advertising.

3. (Unamended) The method according to claim 1, wherein the location based information comprises location based content.

4. (Unamended) The method according to claim 2, wherein the location based advertising includes advertising related to a particular subject matter area.

5. (Unamended) The method according to claim 4, wherein the particular subject matter area is determined based on the user.

6. (Unamended) The method according to claim 3, wherein the location based content includes content related to a particular subject matter area.

7. (Unamended) The method according to claim 6, wherein the particular subject matter area is determined based on the user.

8. (Unamended) The method according to claim 1, wherein the step of determining location data comprises at least one of: receiving location data input by the user, using a network address of a computing/communication device used by the user, using location data determined by the computing/communication device used by the user, using a location table for determining the location data, or receiving location data from a geographic tracking system.

9. (Unamended) The method according to claim 8, wherein the geographic tracking system includes a satellite based tracking system.

10. (Unamended) The method according to claim 1, wherein the steps of determining location data and providing the generated location based information comprises communication with a computing/communication device used by the user.

11. (Unamended) The method according to claim 10, wherein the computing/communication device includes at least one of: a personal digital assistant (PDA) or other portable device, a web browser, a cell or other wireless phone, a electronic billboard, a website, a pager, a television, a web-based television device, an internet enabled device or appliance, a health monitoring device, a kiosk displaying information related to one or more subject areas, a terminal in a library, an Internet radio application, and a job related web site.

12. (Unamended) The method according to claim 4, wherein the subject matter area includes at least one of: home improvement, real estate, real estate professionals, real estate foreclosures and related services, automobiles, repair facilities, delivery services, health care or veterinary professionals or facilities, and professional service providers.

13. (Unamended) The method according to claim 6, wherein the subject matter area includes at least one of: home improvement, real estate, real estate professionals, real estate foreclosures and related services, automobiles, repair facilities, delivery services, health care or veterinary professionals or facilities, and professional service providers.

14. (Unamended) The method according to claim 1, wherein the network is the Internet.

15. (Unamended) The method according to claim 1, wherein the location data of a user includes at least one of: country, state, county, administrative division, geographic or location coordinates, postal code, company regions, population regions, or attribute based regions.

16. (Once Amended) A computer readable data storage medium having program code recorded thereon, that when executed on a computer, displays location based information from an information site on a network, the program code comprising:

a first program code that determines, at the information site, location data of a user of the location based information on the network;

a second program code that generates, at the information site, location based information based on the determined location data of the user; and

a third program code that provides the generated location based information to the user over the network,

wherein the generation of the location based information comprises providing information exclusively from respective sponsors in respective categories of information.

17. (Unamended) The computer readable data storage medium according to claim 16, wherein the location based information comprises location based advertising.

18. (Unamended) The computer readable data storage medium according to claim 16, wherein the location based information comprises location based content.

19. (Unamended) The computer readable data storage medium according to claim 17, wherein the location based advertising includes advertising related to a particular subject matter area.

20. (Unamended) The computer readable data storage medium according to claim 19, wherein the particular subject matter area is determined based on the user.

21. (Unamended) The computer readable data storage medium according to claim 18, wherein the location based content includes content related to a particular subject matter area.

22. (Unamended) The computer readable data storage medium according to claim 21, wherein the particular subject matter area is determined based on the user.

23. (Unamended) The computer readable data storage medium according to claim 16, wherein the first program code determines the location data by at least one of: receiving location data input by the user, using a network address of a computing communication device used by the user, using location data determined by the computing/communication device used by the user, using a location table for determining the location data, or receiving location data from geographic tracking system.

24. (Unamended) The computer readable data storage medium according to claim 23, wherein the geographic tracking system includes a satellite based system.

25. (Unamended) The computer readable data storage medium according to claim 16, wherein the first program code and the third program code communicate with a computing/communication device used by a user.

26. (Unamended) The computer readable data storage medium according to claim 25, wherein the computing/communication device includes at least one of: a personal digital assistant (PDA) or other portable device, a web browser, a cell or other wireless phone, a electronic billboard, a website, a pager, a television, a web-based television device, an internet enabled device or appliance, a health monitoring device, a kiosk displaying information related to one or more subject areas, a terminal in a library, an Internet radio application, and a job related web site.

27. (Unamended) The computer readable data storage medium according to claim 19, wherein the subject matter area includes at least one of: home improvement, real estate,

real estate professionals, real estate foreclosures and related services, automobiles, repair facilities, delivery services, health care or veterinary professionals or facilities, and professional service providers.

28. (Unamended) The computer readable data storage medium according to claim 21, wherein the subject matter area includes at least one of: home improvement, real estate, real estate professionals, real estate foreclosures and related services, automobiles, repair facilities, delivery services, health care or veterinary professionals or facilities, and professional service providers.

29. (Unamended) The computer readable data storage medium according to claim 16, wherein the network is the Internet.

30. (Unamended) The computer readable data storage medium according to claim 16, wherein location data of a user includes at least one of: country, state, county, administrative division, geographic or location coordinates, postal code, company regions, population regions, or attribute based regions.

31. (Once Amended) A system for displaying location based information from an information site on a network, the system comprising:

a host device, connected to the network, that displays location based information to a user; and

a server device, connected to the network, that determines location data of the host device, generates location based information based on the location data of the host device, and transmits the generated location based information for display by the host device, wherein the server device generated location based information comprises information exclusively from respective sponsors in respective categories of information.

32. (Once Amended) A method of displaying information from an information site on a network, the method comprising the steps of:

determining contextual information, other than a location, of a user or a device that uses the information on the network;

generating the information based on the determined contextual information; and providing the generated information over the network to the user or the device.

33. (Once Amended) The method according to claim 32, further comprising determining location data of the user or the device that uses the information, and wherein the step of generating includes generating the information based on both the determined contextual information and the determined location data.

34. (Added) The method according to claim 32, wherein the contextual information comprises a type of the device or a characteristic of the user.

35. (Added) The method according to claim 34, wherein the type of the device comprises one of a laptop, a pager, a cellular phone, an electronic billboard, a GPS receiver or device connected to the GPS receiver, or internet appliance, wherein the characteristic of the user comprises one of an age, gender, nationality, vocation, or profession of the user.

36. (Added) The method according to claim 1, wherein the categories comprise sub-categories and the step of generating location based information further comprises providing information exclusively from respective sub-category sponsors for respective sub-categories.

37. (Added) The method according to claim 1, wherein exclusivity for a sponsor for a particular category is provided for a specific time period.

38. (Added) The method according to claim 37, wherein the exclusivity for a particular time period is provided based on an auction.

39. (Added) The method according to claim 38, wherein an existing exclusive sponsor is permitted to match a highest bid in the auction.